

## **REMARKS**

Claims 1, 3-18 and 20-30 are pending. By this Amendment, Claims 2 and 19 are canceled without prejudice or disclaimer and Claims 1, 3-18 and 20-30 are amended. Claims 1 and 14 have been amended to incorporate the subject matter recited in claims 2 and 19 as well as the features disclosed in the application as originally filed. As such, Applicant respectfully submits that no new matter is presented herein.

### **Provisional Double Patenting Rejection**

Claims 14-30 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over Claims 1-11 of co-pending patent Application Number 10/566,475 to Conti. Applicant respectfully traverses the rejection. As noted by the Office Action, none of the conflicting claims has been indicated as being allowed. As such, Applicant respectfully submits the rejection is premature and should be withdrawn or stayed at least until one of the conflicting claims is indicated as being allowed.

### **Potentially Allowable Subject Matter**

Applicant acknowledges and appreciates the indication by the Examiner that no prior art rejections have been applied against Claims 19, 25 28 and 29/28. In this regard, Applicant has amended Claim 14 to incorporate the subject matter of now canceled Claim 19. As such, besides resolution of the above noted provisional double patenting rejection, Applicant respectfully submits that Claim 14 is in condition for allowance. Claims 15-18 and 20-30 depend from Claim 14. As such, Applicant respectfully submits that these dependent claims should be deemed allowable for at least the same reason(s) Claim 14 is allowable as well as for the additional subject matter recited therein.

### **Claim Rejections – 35 U.S.C. §112**

Claim 29/14 is rejected under 35 U.S.C. §112, second paragraph. Applicant has amended the claim in a manner believed to be responsive to the rejection. As such, withdrawal of the rejection is respectfully requested.

### **Claim Rejections – 35 U.S.C. §102/§103**

Claims 1-10, 14-16, 20-24, 26-27 and 29/14 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,437,294 to Romagnoli. Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over Romagnoli in view of U.S. Patent No. 3,579,350 to Rudd et al. (Rudd). Claims 12-13, 17-18 and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over Romagnoli in view of U.S. Patent No. 5,233,813 to Kenney et al. (Kenney). Applicant respectfully traverses each of the rejections for at least the following reason(s).

Applicant notes that Claims 14-18 and 20-30 are allowable over the applied references for the reason stated above, i.e., the inclusion of the subject matter recited by now-canceled Claim 19, which was not rejected in view of any one or more of Romagnoli, Rudd and Kenney.

Claim 1, as amended herein, recites a method including, among other steps, the step of making the disk by tamping to compress the product by translating and rotating a respective forming piston. As disclosed in the application as originally filed, see, for example, page 7 lines 20-26 and page 11 lines 16-23, the dosing and forming station creates an extremely compact and clean disk of a precisely dosed product *thanks to the simultaneous translational and rotational movements of the forming pistons*. In particular, the rotational movement enables the disk to be tamped quickly and in a short path length

and without allowing it to adhere to the surface of the impression.

Applicant respectfully submits that Romagnoli does not disclose or otherwise suggest the discussed step(s). Rather, Romagnoli discloses a method for making pods of filter material by making at least one compressed disk of product at respective dosing and forming stations. The step of making the disk comprises a step of tamping to compress the product only by translating a respective forming piston, i.e., Romagnoli does not disclose or suggest any rotational movement of the forming pistons and therefore does not derive the benefit of the disk being tamped quickly, in a short path length, and without allowing the disk to adhere to the surface of an impression. As such, Romagnoli does not create an extremely compact and clean disk of precisely dosed product, which is provided by the invention recited by Claim 1.

To qualify as prior art, each and every feature recited by a rejected claim must be disclosed by the applied art of record. Since Romagnoli does not disclose or suggest the each and every feature recited by Claim 1, Applicant respectfully submits that Romagnoli does not anticipate or render obvious Claim 1. As such, Applicant respectfully submits that Claim 1 should be deemed allowable over Romagnoli.

Rudd is applied for teaching the use of suction through vacuum channels in a support to assist in the formation of a disk of material. However, Rudd does not overcome or otherwise address the above-stated deficiency of Romagnoli.

Kenney is applied for teaching an apparatus giving heat sealing rollers that join filter webs and having a knife that separates pods from each other. As such, Applicant submits that Kenney, like Rudd above, does not overcome or otherwise address the above-stated deficiency of Romagnoli.

For all of the reasons provided above, Applicant respectfully submits that Claim 1 should be allowable over Romagnoli, Rudd and Kenney, alone or in any combination thereof.

Claims 3-13 depend from Claim 1. it is respectfully submitted that these dependent claims be deemed allowable for at least the same reasons Claim 1 is allowable, as well as for the additional subject matter recited therein.

Applicant respectfully requests withdrawal of all three rejections.

**Conclusion**

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding rejections, allowance of Claims 1, 3-18 and 20-30, and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing docket number 023349.00314**.

Respectfully submitted,



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Enclosure: Petition for Extension of Time

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